

REMARKS/ARGUMENTS

The Office Action has been carefully considered and the foregoing amendments are made in response thereto in compliance with 37 C.F.R. § 1.116 to place all remaining claims in condition for allowance.

Before entry of this Amendment & Response, the status of the application is as follows:

- Claim 116 is objected to by the Examiner because of an informality in the claim language.
- Claims 105, 107-109, 111-112, 115-120, and 122-123 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,199,431 to Kittrell et al. ("Kittrell").
- Claims 106, 110, 113-114, 121, and 124 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kittrell.

Applicants hereby amend claims 105-107, 115-116, 118, 121, and 123-124, add new claims 125-147, and cancel claim 112 in compliance with 37 C.F.R. §1.121(c). Claim 116 has been amended to correct a claim informality. Claims 105-107, 115-116, 118, 121, and 123-124 have been amended to more clearly claim Applicants' invention. Support for the amendments can be found at least at pages 13-24, 31, and 36-39, of Applicants' specification. No new matter has been added thereby. Applicants respectfully submit that claims 105-147 are in condition for allowance.

1. Claim 116 is objected to because of an informality in the claim language. The Examiner indicates that it is unclear how a step can comprise a structural element. Claim 116 is hereby amended to specify that the array of detectors detects the emanating radiation. No new matter has been entered thereby. Applicants thus respectfully submit that claim 116 is in condition for allowance.

2. Claims 105, 107-109, 111-112, 115-120, and 122-123 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kittrell. Applicants respectfully traverse this rejection as applied to the claims, as amended. For a claim to be anticipated under 35 U.S.C. § 102(b), the reference must teach or suggest each and every limitation in the claim. Applicants respectfully submit that Kittrell does not disclose every claim element of the claimed invention as presently amended. Specifically, Kittrell does not teach or suggest, at least, that the emanating radiation is substantially confocal with electromagnetic radiation provided in the illuminating step.

Applicants' claimed invention involves a method for analyzing a biological sample. As recited in representative amended claim 105, Applicants' invention includes, in part, collecting electromagnetic radiation emanating from sequential regions of a sample, wherein the emanating electromagnetic radiation is substantially confocal with electromagnetic radiation provided in an illumination step.

Briefly, Kittrell discloses an optical needle for illuminating a tissue and for receiving light returning from the tissue. Because Kittrell does not teach or suggest, collecting electromagnetic radiation emanating from sequential regions of a sample, wherein the emanating electromagnetic radiation is substantially confocal with electromagnetic radiation provided in an illumination step, Applicants respectfully submit Kittrell fails to anticipate the present invention under 35 U.S.C. § 102(b). Applicants thus respectfully submit that claim 105 is in condition for allowance. Because claims 107-109, 111-112, 115-120, and 122-123 depend directly or indirectly from independent claim 105, Applicants respectfully submit these claims are allowable as well.

3. Claims 106, 110, 113-114, 121, and 124 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kittrell. For the rejection under 35 U.S.C. §103(a) to be proper the reference, either alone or in combination with another reference, must teach or suggest all of the claim limitations. For the same reasons as described above regarding claim 105, Applicants respectfully submit that Kittrell, either alone or in combination with another reference, does not teach or suggest collecting electromagnetic radiation emanating from sequential regions of a sample, wherein the emanating electromagnetic radiation is substantially confocal with electromagnetic radiation provided in an illumination step. Since claims 106, 110, 113-114, 121, and 124 each depend directly or indirectly from independent claim 105, Applicants respectfully submit that these claims also are allowable.

4. Applicants have added new claims 125-147 in compliance with 37 C.F.R. § 1.121(c). The amendments to the claims are supported in the application at, for example, pages 13-24, 31, and 36-39.

Claims 125-126 depend indirectly from independent claim 105 and further specify that the mirror is a beam splitter, and that the sheath is a single-use disposable sheath, respectively.

New independent claim 127 involves a method for analyzing a biological sample that includes controlling a field stop in order to probe a volume element of the sample. Applicants respectfully submit that no new matter is introduced by the present Amendment and Response. Applicants respectfully submit that Kittrell does not teach or suggest, controlling a field stop in order to probe a volume element. Applicants thus respectfully submit that claim 127 is in condition for allowance.

Since claims 125-126 each depend indirectly from independent claim 105, Applicants respectfully submit that these claims also are allowable. Further, since claims 128-147 each depend directly or indirectly from independent claim 127, Applicants respectfully submit that these claims also are allowable.

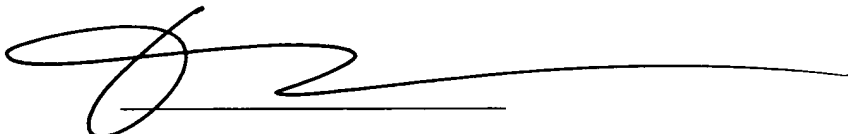
CONCLUSION

In view of all of the foregoing reasons, Applicants respectfully request reconsideration, withdrawal of all grounds of rejection and objection, and allowance of claims 105-147 in due course. The Examiner is invited to contact Applicants' undersigned representative by telephone at (617)-248-7013 to discuss any outstanding issues.

Respectfully submitted,

Date: December 1, 2003

Testa, Hurwitz & Thibault, LLP
125 High Street
Boston, MA 02110
Tel. No.: (617) 248-7013
Fax No.: (617) 248-7100

A handwritten signature in black ink, consisting of a large, stylized 'T' followed by a long, horizontal, wavy line extending to the right.

Thomas C. Meyers
Reg. No. 36,989
Attorney for Applicants